

REMARKS

Summary of Amendments Made

The typographical error in claim 1 has been corrected, however, the phrase "water-jet-consolidated" was not used in claim 4. If there was some other objection to claim 4 and this is the only issue remaining for preventing a Notice of Allowance, the examiner is reminded that MPEP 1302.04 authorizes Examiner's Amendment to correct various minor errors (see page 1300-3 from August 2001 version).

Claim 1 has also been further amended by including the limitations of claims 2 and 4. Claim 8 has been amended to refer to oil-free preparations (support can be found, e.g. on page 3, lines 4-6 of the specification. New claims 10-12 are similar to the limitations of claims 3, 5 and 8 respectively. Claims 13 and 14 further define the impregnation solution.

Claims 1, 3, 5 and 7-14 are now pending. Claims 2 and 4 have been cancelled and claim 6 was withdrawn from consideration. It is believed that no new matter has been added.

Information Disclosure Statement

The Examiner returned the Information Disclosure Statement without marking off as having been considered the references listed in the "Foreign Patent Documents" section or given a reason for non-consideration of these references in her Office Action (at the very least both EP 652 988 B1 and EP 792 144 B1 should have been marked as considered as both in the English language).

Such that the German language references were not understood, an English language abstract is being provided for with English language abstracts for DE 42 04 222, DE 40 00 920; DE 299 04 320 = EP 1034701 from the EPO web site. Claim 1 of DE 296 12 828 U (Erfrischungstuch = literal translation "refreshing cloth") can be roughly translated as follows:

1. Erfrischungstuch aus einem mit einer wässrigen alkoholischen Lösung getränkten Papier- oder Faservlies, gekennzeichnet durch in dem Tuch angeordnete, aus Kunststoff bestehende Kapsein zur Aufnahme von Wirkstoffen, wie Seife, Desodorantien, Duftmittel od. dgl.

1. "Refreshing cloth" with an aqueous alcoholic solution impregnated in paper or nonwoven fabric, characterized in that the cloth is prepared for a plastic capsule for delivering an agent such as a soap, deodorant, perfume and the like.

35 U.S.C. 103(a) rejection

Claims 1-5 and 7-9 were rejected as being obvious over Simon (U.S. Patent 6,245,322) in view of Brennan et al. (U.S. Patent 6,361,784). The applicants' reserve the right to further prosecute the original scope of the claims based on this rejection in a divisional application as it is noted that this rejection did not address the limitations of claims 2 and 3. However, in the interest of compact prosecution, additional limitations have been added to claim 1 to further distinguish the claimed invention over the prior art.

Although the applicants' realize that the Simon and Brennan et al. were not formulated by the Examiner with the current claims in mind, the applicants would like to make the following points for the Examiner's consideration prior to issuing a communication regarding the claims:

- (1) It is believed that the prior art does not teach, suggest or provide motivation to one of ordinary skill in the art who has the references before him but not the applicants claims to act as a guide (see MPEP 2142) the applicants impregnated wipes as currently claimed.
- (2) Claim 3 uses the term "consist" which is the narrowest of the transitional terms; the Simon reference was directed toward the use of oil-in-water emulsions which is outside the scope of this claim.
- (3) Claim 8 as amended is directed toward an oil-free impregnation solution which is also not taught by the Simon reference.
- (4) Claim 13 is directed toward an impregnation solution which is not taught by Simon.
- (5) If an "optimization of ranges" argument is presented, it is noted that the prior art reference must teach that the variable is a result effective variable, not that one of ordinary skill could experiment with the ranges if necessary. MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)."
- (6) If an "inherency" argument is presented, it is noted that MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "The fact that a certain result or characteristic may

occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the **extrinsic evidence** must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted), i.e. Inherency is a question of fact which must be supported with extrinsic evidence if the prior art does not specifically recite the element deemed to be inherent by the Examiner.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee

Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

Attachment: Copy of originally filed Information Disclosure Statement from 17 December 2001 with English language abstracts for DE 42 04 222, DE 40 00 920; DE 299 04 320 = EP 1034701

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (7 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 30 April 2004

By: Agata Glinska

Agata Glinska